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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/036,725	12/21/2001	Wendell B. Halbrook JR.	9240.00	5770

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EXAMINER

HESS, BRUCE H

ART UNIT

PAPER NUMBER

1774

DATE MAILED: 09/04/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

AS-8

Office Action Summary

Application No.

10/036,725

Applicant(s)

Halbrook et al.

Examiner

Bruce Hess

Group Art Unit

1774

— The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address —

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- ☒ Responsive to communication(s) filed on Paper No. 7 (Election)
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 1 1; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 1-19 is/are pending in the application.
- Of the above claim(s) _____ is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 1-3 and 5-13 is/are rejected.
- ☒ Claim(s) 4 and 14-19 is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement

Application Papers

- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119 (a)-(d).
- ☐ All ☐ Some* ☐ None of the:
- ☐ Certified copies of the priority documents have been received.
- ☐ Certified copies of the priority documents have been received in Application No. _____.
- ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a))

*Certified copies not received: _____

Attachment(s)

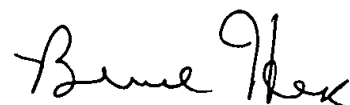
- ☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 5
- ☐ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Interview Summary, PTO-413
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Other _____

Office Action Summary

1. Upon reconsideration, the election of species is withdrawn.
2. Claims 4 and 14-19 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.
3. Claim 2 is rejected under 35 U.S.C. 112 (second paragraph) as being indefinite in the recital of backing comprised only of polymer. It is suggested that the term "further" be inserted before "comprised".
4. Claims 1, 3 and 5-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over the patent to Chang (USP 5,595,955).

Chang teaches a security feature applied to the back of documents. The security feature comprises an encapsulated optically variable compound (i.e., a thermochromic compound) which when written on forms a latent image which can be later verified by the application of heat (see column 13, lines 7-25). Since documents routinely employ thermosensitive coatings on the face thereof, use of a thermosensitive coating on the upper face of the Chang document would have been an obvious expedient to one of ordinary skill in this art in the absence of unexpected results.

5. Tan et al are cited for their teaching of thermosensitive recording material employing optically variable compounds in back coatings. These back coatings do not have additional images printed thereon, however.



BRUCE H. HESS
PRIMARY EXAMINER